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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P03040US2A; 295620-214271

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Application Number

10/567,986

Filed

July 5, 2007

First Named Inventor

Lanzarotta et al.

Art Unit

1796

Examiner

William Cheung

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 56,218

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

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May 3, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re. application of : Lanzarotta
Serial No. : 10/567,986
Filed : July 5, 2007
For : Non-Staining Black Sidewall
Group Art Unit : 1796
Examiner : William Cheung
Confirmation No. : 7510

PRE-APPEAL BRIEF CONFERENCE REQUEST

Sir:

The Examiner has finally rejected claims 1-20 as being unpatentable under 35 U.S.C. §102 and § 103. The rejections of these claims are now appealed. Applicants hereby request review of the Final Rejection prior to filing an Appeal Brief for the reasons set forth below. Any fees due should be charged to Deposit Account No. 060925, ref: P02083US1A.

I. The Rejection of Claim 16 is Clearly Erroneous and Does not Make a Prima Facie Case of Unpatentability

Claim 16 states:

16. The rubber composition of Claim 1, wherein the composition is exclusive of an alkali metal salt of an alkylsulphonic or alkylsulphuric acid.

Claim 16 is rejected under 35 U.S.C. § 103; however, the limitations of claim 16 were not addressed at all in the Final Office Action, the limitations have still not been addressed, and the arguments in the Advisory Actions are clearly erroneous. A prima facie case of unpatentability has not been made against these claims, and does not exist because the cited Bataille (U.S. 6,554,037) reference, which is discussed in the background section of the present application, contains the alkali metal salt of an alkylsulphonic or alkylsulphuric acid, which is excluded by claim 16. Thus, claim 16 is not obvious over the prior art.

The advisory action of March 19, 2010 states: “‘exclusive of’ is not same as ‘exclusion of.’ Applicants must recognize that the recitation ‘exclusion of’ means the exclusion of ingredients other than the ‘alkali metal salt of an alkylsulphonic or alkylsulphuric acid’ being claimed.”

It is clearly erroneous to suggest that claim 16 means that the rubber composition excludes everything *other than* “an alkali metal salt of an alkylsulphonic or alkylsulphuric acid.” The term “exclusive of” clearly means “not including.” This was supported by the dictionary definition submitted with the response on March 14, 2010.

The Examiner alleged in the Advisory Action that the undersigned made confusing remarks as to the meaning of claim 16 in the response of March 10, 2010. However, the

undersigned reviewed these remarks and they are consistent with the plain meaning of the claim as argued above: “A prima facie case of unpatentability has not been made against these claims, and does not exist because Bataille contains the alkali metal salt of an alkylsulphonic or alkylsulphuric acid that is excluded by claim 16.”

Accordingly, the rejection of claim 16 is clearly erroneous.

II. Rejections of Claims 1-7 and 11-12 Under 35 U.S.C. § 102

The Final Office Action and subsequent Advisory Actions fail to make a prima facie case of anticipation by Bruck (DE 3501697). The Final Office Action completely omits any reference to the “one or more antidegradants” claim element. The Bruck reference does not disclose this element.

The Advisory Action states that Bataille discloses this element. However, the anticipation rejection was based on Bruck, not Bataille. It is clearly erroneous to combine references for an anticipation rejection. If the Examiner wanted to make an obviousness rejection, this should have been done in a new non-final action, not in an advisory action.

In addition, it is also apparent that the Bruck reference does not teach the use of any of the rubbers recited in the Markush group of claim 1. Instead, Bruck teaches the use of combinations of NBRs and EPDM. NBR and EPDM are not any of the specific rubbers listed in claim 1 (NBR is not a type of butadiene rubber, because it contains the acrylonitrile monomer in addition to butadiene), and they also do not fit under the category of thermoplastic rubbers listed at the end of the Markush group. It is clear to one of skill in the art that EPDM is not a thermoplastic rubber, this can be confirmed by a simple web search.

Applicants have also submitted a Declaration to prove that EPDM is not a thermoplastic rubber, and it cites several corroborating sources. This Declaration should have been entered (because the Examiner only raised this issue in the Advisory Action and ignored the Applicant's arguments in the Final Office Action), but was not. Applicants have since filed a supplemental response requesting reconsideration of the non-entry of this Declaration. The Examiner apparently considered the Declaration anyway, because he addressed it in the most recent Advisory Action and argued that EPDM is thermoplastic before it is crosslinked. This interpretation is clearly erroneous and would completely eviscerate the meaning of the term thermoplastic rubber. The Examiner's definition would make all rubbers thermoplastics, since they are all at some point uncrosslinked. The term thermoplastic rubber is based on the qualities of the rubber after it is crosslinked. Thus, this argument is clearly erroneous.

Even if the claims were rejected under § 103, they are not obvious over Bruck in view of Bataille. As explained above, the Bruck reference is missing at least two elements of independent claim 1. Regarding the antidegradant element, one of skill in the art would not be motivated to use any antidegradants with the compositions disclosed in Bruck, since Bruck discloses that its NBR/EPDM mixtures are already known to have good "ozonosphere resistance." As explained in previous responses, one of skill in the art would not be motivated to add antidegradants to a rubber that is already formulated for good ozonosphere resistance. Regarding the polymer element, the Bruck reference teaches away from modifying the polymer element from the NBR/EPDM blend that it teaches. This is because the benefits of Bruck over the prior art it discloses are attributable to the specific blend of NBR and EPDM. Accordingly, the Bruck reference would no longer be suitable for its intended purpose if the polymer were modified to be one of the rubbers listed in claim 1.

Accordingly, a prima facie case of unpatentability was not made against claims 1-7 and 11, which were only rejected over Bruck under 102(b). A prima facie case of unpatentability was also not made against claims 12-16, which also depend from claim 1.

III. Rejections of Claims 8-10 and 12-20 Under § 103

Claims 12-16 are dependent on claim 1, and thus a prima facie case of obviousness has not been made against those claims as explained above. Furthermore, a prima facie case of obviousness has not been made against claims 8-10 and 17-20, because of the lack of a motivation to combine and the teaching away in Bataille as explained in the previous responses. This rejection is not discussed in depth here, however, the most egregious errors are discussed in the previous sections of this Request, and these are sufficient grounds for prosecution to be reopened.

Respectfully submitted,

5/3/10



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